UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/425,736	10/22/1999	YUSAKU FUJII	991176	9951

23850   7590   11/12/2003

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EXAMINER
JACK, TODD M

ART UNIT	PAPER NUMBER
2133	

DATE MAILED: 11/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

		Application No.	Applicant(s)
Office Action Summary		09/425,736	FUJII ET AL.
		Examiner	**Art Unit**
		Todd M Jack	2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>22 October 1999</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-22</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-22</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☒ All b) ☐ Some * c) ☐ None of:

        1. ☐ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 102

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1, 5, 12, and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Pare.

Claim 1: Pare (6,581,042 B2) teaches an illegal access discriminating apparatus comprising: individuals with PINs are identified by comparison with a biometric-PIN database (col. 9, lines 57-65), the ID module detects a payee or payor by conducting a re-registration check (col. 9, lines 33-41), the database of parties identifiable from biometric-PIN combinations are distributed equally across all processors (col. 9, lines 53-56), and a subsystem comprises two processors, each is capable of identifying parties from their biometric and PIN codes (col. 9, lines 50-52) by receiving a biometric sample and PIN for identification and searching through its database for biometric samples that match (col. 9, lines 57-67 and col. 10, lines 1-8).

Claim 5: Further, Pare teaches a payer enters a PIN code into the keypad, then transmits the biometric-PIN for identification along with the hardware code and identifies the payer using the biometric sample (col. 13, lines 66-67 and col. 14, lines 1-8).

Claim 12: Pare teaches an illegal access discriminating method comprising: individuals with PINs are identified by comparison with a biometric-PIN database (col. 9, lines 57-

65), the ID module detects a payee or payer by conducting a re-registration check (col.

9, lines 33-41), and once all biometric samples are retrieved, the processor compares

the bid biometric from the message to all retrieved biometric samples, and a match

triggers a notification to the transaction processor or transmits a "party not identified"

message to the transaction processor if no match is made (col. 10, lines 2-8).

Claim 13: Further, Pare teaches a storing step comprises: an illegal access

discriminating method comprising: individuals with PINs are identified by comparison

with a biometric-PIN database (col. 9, lines 57-65).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 2-4, 6-11, and 14-22 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Pare in view of Gressel.

Claim 2: Pare teaches an illegal access discriminating method comprising: individuals

with PINs are identified by comparison with a biometric-PIN database (col. 9, lines 57-

65). Pare fails to teach a use information-storing unit for storing ID information and

organic information based on the authentication demand, which the service providing

system received in the past from the user. Gressel (6,311,272 B1) teaches smart cards

terminals with memory that include an encrypted biometric data archive (col. 4, lines 26-29). It would have been obvious to combine Gressel's teachings to Pare because it would allow information storing for use of the data at a later time by forming an archive secured through the use of encryption.

Claim 3: Pare fails to teach control unit determines that there is the authentication demand by the illegal access person in the case where the ID information does not coincide and the organic information coincides or the case where the ID information coincides and the organic information does not coincide on the basis of the output of the comparing and collating unit. Gressel teaches two typical proximity thresholds for biometric sampling, which are monitored for imposters attempting to enter unauthorized (col. 10, lines 26-34). It would have been obvious to combine Gressel's teachings to Pare because it would allow unauthorized entries to be halted.

Claim 4: Pare fails to teach a timer unit for measuring a time and wherein the ID information and organic information, which were inputted in the past after the elapse of a predetermined time from the storage on the basis of time information measured by the timer unit are erased and excluded from targets of the comparison and collation. Gressel teaches upon successful completion of the biotest, the user's biometric features are encoded into the smart card. The original template threshold value is a parameter, which is typically determined by the system application owner, depending on the application. (col. 12, lines 42-48). It would have been obvious to combine Gressel's

teachings to Pare because it would allow only a reasonable amount of time to transfer

the biometric features, thus discouraging break-ins. The thresholds and templates are

only read from the user.

Claim 6: Pare fails to teach the inputted organic information and the organic information

which was inputted in the past coincide, the control unit detects a combination in which

the organic information coincides and the ID information differs, and when the number,

the control unit determines that there is the authentication demand by the illegal access

person. Gressel teaches a false rejection rate rejects a percentage of individuals when

the meeting of the two (false acceptance rate and false rejection rate) nears the

threshold (col. 10, lines 5-23). It would have been obvious to combine Gressel's

teachings to Pare because it would allow the attempted user to be authenticated.

Claim 7: Pare fails to teach an ID information comparing unit for comparing the inputted

ID information and the ID information which was inputted in the past and generating a

signal indicative of coincidence or dissidence and an organic information collating unit

for comparing the inputted organic information and the organic information which was

inputted in the past, generating a signal indicative of coincidence of the organic

information in the case where a value of a predetermined coincidence degree or more is

obtained and generating a signal indicative of dissidence of the organic information in

the case where a value less than the predetermined coincidence degree is obtained.

Gressel teaches a percentage of the population would be rejected and the guards would

be signaled (col. 10, lines 48-54). Also, Gressel teaches a false acceptance rate and false rejection rate (col. 9, lines 50-67) and upon comparison with the threshold value, a large subgroup would be allowed entry (col. 9, lines 50-67 and col. 10, lines 1-5). It would have been obvious to combine Gressel's teachings to Pare because it would allow personal information to be used in records for authorization with a specific individual.

Claim 8: Pare fails to teach a timer unit for measuring a time and wherein the ID information and organic information, which were inputted in the past after the elapse of a predetermined time from the storage on the basis of time information measured by the timer unit are erased and excluded from targets of the comparison and collation. Gressel teaches upon successful completion of the biotest, the user's biometric features are encoded into the smart card. The original template threshold value is a parameter, which is typically determined by the system application owner, depending on the application. (col. 12, lines 42-48). It would have been obvious to combine Gressel's teachings to Pare because it would allow only a reasonable amount of time to transfer the biometric features, thus discouraging break-ins. The thresholds and templates are only read from the user.

Claim 9: Pare teaches an ID module conducts a re-registration check and comparing the registration biometric sample with other biometric samples (col. 9, lines 33-41). Pares fails to teach the storing unit stores a telephone number serving as a transmitting

source and a terminal position such as a network address or the like together with the

ID information and organic information which were inputted in the past. Gressel

teaches secret keys and random numbers are internally generated in smart cards and

security application modules in terminal devices. Biometric data in a secure system is

equivalent to pins and passwords. (col. 11, lines 47-57). It would have been obvious to

combine Gressel's teachings to Pare to designate a personal ID as telephone numbers

and biometric data to increase the security of the apparatus.

Claim 10: Pare fails to teach an authentication demand terminal address recording unit

for recording the number of times of authentication demand every terminal address and

the same terminal access detecting unit for detecting that the authentication demand of

a predetermined number or more has been performed within a predetermined time with

reference to the authentication demand terminal address, activating the comparing and

collating unit and the control unit and allowing an illegal access to be discriminated.

Gressel teaches the use of an original template threshold value, which sets values that

are larger than the user's smart card threshold value. This threshold value is

incremented appropriately and thus records the demands on the authentication process.

Gressel teaches the use of a biotest to compare fingerprints where only 3 percent of the

population would be rejected (col. 12, lines 45-51). It would have been obvious to

combine Gressel's teachings to Pare because preliminary screening of users reduces

fraudulent access to the authentication system, thus reducing processor time.

Claim 11: Pare fails to teach that when it is determined that there is the authentication demand by the illegal access person, the control unit automatically notifies an administrator of the service providing system of a result of the discrimination. Gressel teaches a rejection results in the further processing of the applicant by a guard (col. 10, lines 48-54). The guard is comparable to an administrator. It would have been obvious to combine Gressel's teachings to Pare because the use of an administrator's intervention would facilitate the accuracy of the authentication process.

Claim 14: Pare fails to teach a control step, it is determined that there is the authentication demand by the illegal access person in the case where the ID information does not coincide and the organic information does not coincide on the basis of the output in the comparing and collating step. Gressel teaches that 3% of the population would be rejected regardless of the value of the threshold. Human intervention then becomes necessary to process the applicant. (col. 10, lines 48-54) It would have been obvious to combine Gressel's teachings to Pare because of the need to resolve the authentication of applicants who qualify for access with a valid threshold value, but not qualifying organic information.

Claim 15: Pare fails to teach telephone number serving as a transmitting source, a terminal position such as a network address, and an input time in correspondence to the ID information and organic information which were inputted in the past are stored and in the control step, it is determined that there is the authentication demand by the illegal

access person in the case where the comparison result in the comparing and collating

step between the inputted from a same terminal position within a predetermined time

indicates dissidence. Gressel teaches secret keys and random numbers are internally

generated in smart cards and security application modules in terminal devices.

Biometric data in a secure system is equivalent to pins and passwords. (col. 11, lines

47-62). An original template resides in the terminal while a threshold value is in a user's

smart card (col. 12, lines 46-51). 3% of the population would be rejected regardless of

the value of the threshold. Human intervention then becomes necessary to process the

applicant. (col. 10, lines 48-54) It would have been obvious to combine Gressel's

teachings to Pare to designate a personal ID as telephone numbers and biometric data

to increase the security of the apparatus, to store the information to use for

authentication, and because of the need to resolve the authentication of applicants who

qualify for access with a valid threshold value, but not qualifying organic information.

Claim 16: Pare fails to teach past ID information has a serial number for the inputted ID

information or not is discriminated and, when it is determined that the past ID

information has the serial number, it is determined that there is the authentication

demand by the illegal access person at a predetermined designated number of times.

Gressel teaches a fingerprint scan is used in a biotest scan, the threshold value has

little effect on the test, and an illegal access person has a limited number of tries

because of their fear of being caught (col. 10, lines 40-47). It would have been obvious

to combine Gressel's teachings to Pare because a biotest scan would deter

unauthorized access attempts and minimize the authentication systems use of the processor.

Claim 17: Pare fails to teach the inputted organic information and the organic information, which was inputted in the past coincide, a combination in which the organic information coincides and the ID information differs is detected, and when the number of the combinations reaches a predetermined number, it is determined that there is the authentication demand by the illegal access person. Gressel teaches two typical proximity thresholds for biometric sampling, which are monitored for imposters attempting to enter unauthorized (col. 10, lines 26-47). It would have been obvious to combine Gressel's teachings to Pare because it would allow unauthorized entries to be halted.

Claim 18: Pare fails to teach an ID information comparing unit for comparing the inputted ID information and the ID information which was inputted in the past and generating a signal indicative of coincidence or dissidence and an organic information collating unit for comparing the inputted organic information and the organic information which was inputted in the past, generating a signal indicative of coincidence of the organic information in the case where a value of a predetermined coincidence degree or more is obtained and generating a signal indicative of dissidence of the organic information in the case where a value less than the predetermined coincidence degree is obtained. Gressel teaches a percentage of the population would be rejected and the

guards would be signaled (col. 10, lines 48-54). Also, Gressel teaches a false

acceptance rate and false rejection rate (col. 9, lines 50-67) and upon comparison with

the threshold value, a large subgroup would be allowed entry (col. 9, lines 50-67 and

col. 10, lines 1-5). It would have been obvious to combine Gressel's teachings to Pare

because it would allow personal information to be used in records for authorization with

a specific individual.

Claim 19: Pare fails to teach a timer unit for measuring a time and wherein the ID

information and organic information, which were inputted in the past after the elapse of

a predetermined time from the storage on the basis of time information measured by the

timer unit are erased and excluded from targets of the comparison and collation.

Gressel teaches upon successful completion of the biotest, the user's biometric features

are encoded into the smart card. The original template threshold value is a parameter,

which is typically determined by the system application owner, depending on the

application. (col. 12, lines 42-48). It would have been obvious to combine Gressel's

teachings to Pare because it would allow only a reasonable amount of time to transfer

the biometric features, thus discouraging break-ins. The thresholds and templates are

only read from the user.

Claim 20: Pare fails to teach a timer unit for measuring a time and wherein the ID

information and organic information, which were inputted in the past after the elapse of

a predetermined time from the storage on the basis of time information measured by the

timer unit are erased and excluded from targets of the comparison and collation.

Gressel teaches upon successful completion of the biotest, the user's biometric features

are encoded into the smart card. The original template threshold value is a parameter,

which is typically determined by the system application owner, depending on the

application. (col. 12, lines 42-48) The ID module detects a payee or payor by

conducting a re-registration check (col. 9, lines 33-41). It would have been obvious to

combine Gressel's teachings to Pare because it would allow only a reasonable amount

of time to transfer the biometric features, thus discouraging break-ins. The thresholds

and templates are only read from the user.

Claim 21: Pare fails to teach an authentication demand terminal address recording unit

for recording the number of times of authentication demand every terminal address and

the same terminal access detecting unit for detecting that the authentication demand of

a predetermined number or more has been performed within a predetermined time with

reference to the authentication demand terminal address, activating the comparing and

collating unit and the control unit and allowing an illegal access to be discriminated.

Gressel teaches the use of an original template threshold value, which sets values that

are larger than the user's smart card threshold value. This threshold value is

incremented appropriately and thus records the demands on the authentication process.

Gressel teaches the use of a biotest to compare fingerprints where only 3 percent of the

population would be rejected (col. 12, lines 45-51). It would have been obvious to

combine Gressel's teachings to Pare because preliminary screening of users reduces

fraudulent access to the authentication system, thus reducing processor time.

Claim 22: Pare fails to teach that when it is determined that there is the authentication

demand by the illegal access person, the control unit automatically notifies an

administrator of the service providing system of a result of the discrimination. Gressel

teaches a rejection results in the further processing of the applicant by a guard (col. 10,

lines 48-54). The guard is comparable to an administrator. It would have been obvious

to combine Gressel's teachings to Pare because the use of an administrator's

intervention would facilitate the accuracy of the authentication process.

CONCLUSION

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Todd M Jack whose telephone number is 703-305-1027.

The examiner can normally be reached on M-Th, alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Albert DeCady can be reached on 703-305-9595. The fax phone numbers

for the organization where this application or proceeding is assigned are 703-746-7239

for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is 305-3900.

Todd Jack
October 8, 2003

SUPERVISORY PATENT EXAMINER
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